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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Gross et al.
Appl. No. : 09/643,141
Filed : 08/22/00
Title : GRAFFITI REMOVER, PAINT STRIPPER, DEGREASER

Grp./A.U. : 1746
Examiner : B. Carrillo

Docket No. : M 6636 CC/CSAP

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 1, 2003.

July 1, 2003
Date

Marlene Capreri
Signature of certifier

Marlene Capreri
Typed or printed name of certifier

APPEAL BRIEF TRANSMITTAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 222313-1450

Sir:

Appellants' brief, in triplicate, is transmitted herewith in accordance with 37 CFR 1.192.

Please charge the required fee of \$320.00 to our Deposit Account No. 50-1177. This paper is enclosed in triplicate. Order No. 03-0323.

The Commissioner is hereby authorized to charge any deficiency in the required fee or to credit any overpayment to Deposit Account 50-1177.

Respectfully submitted,

Cognis Corporation
2500 Renaissance Blvd., St. 200
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Attorney for Applicant(s)
(610) 278-4929



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Alexandria, VA 22313-1450

BRIEF ON APPEAL UNDER 37 C.F.R. 1.192

Sir:

REAL PARTY IN INTEREST

The real party in interest is Cognis Corporation, 5051 Estecreek Drive,
Cincinnati, OH 45232.

RELATED APPEALS AND INTERFERENCES

None.

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STATUS OF CLAIMS

Claims 33-50, 53 and 54 are the subject of this appeal.

STATUS OF AMENDMENTS

No amendments were made after final rejection.

SUMMARY OF THE INVENTION

Briefly stated, the present invention is directed to a process for cleaning hard surfaces involving contacting the hard surfaces with a terpene-free cleaning composition containing from about 2 to about 12% by weight of an oil-soluble anionic surfactant, from about 0.2 to about 6% by weight of a water-soluble anionic surfactant, from about 3 to about 96% by weight of a primary solvent based on a C₁₋₄ alkyl ester of a C₆₋₂₂ saturated or unsaturated carboxylic acid, from about 2 to about 14% by weight of a short-chain co-surfactant, and remainder, to 100%, water. See page 8, line 16, to page 10, line 10 of the application.

ISSUES

Whether claim 46 is indefinite under 35 U.S.C. § 112, second paragraph. *W.K. Stevenson*

Whether claims 33, 34, 36-42 and 44-48 are anticipated under 35 U.S.C. § 102(e) by Stevens (US Patent No. 6,172,031). ✓

Whether claims 35 and 43 are obvious under 35 U.S.C. § 103(a) over Stevens (US Patent No. 6,172,031). ✓

Whether claims 49 and 50 are obvious under 35 U.S.C. § 103(a) over Stevens (US Patent No. 6,172,031) in view of Van Eenam (US 5,585,341). ✓

Whether claims 53 and 54 are obvious under 35 U.S.C. § 103(a) over Stevens (US Patent No. 6,172,031) in view of Cilley (US 6,180,583). ✓

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GROUPING OF THE CLAIMS

The claims stand and fall together.

ARGUMENT

Claim 46 sufficiently definite, as written, to satisfy the requirements under 35 U.S.C. 112, second paragraph.

Initially, Appellant would like to note that it is well settled that claim terminology is sufficiently definite under 35 U.S.C. § 112, second paragraph, unless there is an **unreasonable degree of uncertainty** in view of the specification and the art as to what is being claimed. See, *In re Johnson and Farnum*, 194 USPQ 187, 193 and 194 (CCPA 1977)(emphasis added).

Appellant respectfully submits that it is clear from both the specification and the art, that the plain meaning of the term “thermal stability”, as it is understood by those skilled in the art, is obviously what is meant thereby. More particularly, the composition does not suffer any deleterious effects when exposed to temperatures spanning the claimed temperature range. Furthermore, while the Examiner has indicated that it is not clear whether the “composition” or “a specific component thereof” is “thermally stable”, Appellant would like to note that since the objected-to term clearly refers to the “composition” in claim 46 as being “thermally stable”, it is obviously the “composition” that is thermally stable, not a specific component thereof.

Stevens '031 fails to anticipate the claimed invention on the grounds that it fails to disclose each and every element thereof.

Appellant would first like to note that it is extremely well settled that a factual determination of anticipation requires the disclosure, in a single reference, of each and every element of the claimed invention, and an Examiner must identify wherein each and every facet of the claimed invention is disclosed in the applied reference. See, *In re Levy*,

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17 USPQ2d 1561 (Bd. Pat. App. & Inter. 1990). As a result, Appellant respectfully submits that this reference fails to anticipate the claimed invention on the grounds that it fails to disclose each and every element thereof.

Appellant has argued that whereas the present invention requires that its composition be terpene-free, the Stevens reference favors the presence of terpene in its composition. Consequently, since this element of the claimed invention is not disclosed by Stevens, for this reason alone, the reference should not be held to anticipate the present invention.

The Examiner contends, however, that because Stevens **suggests** that its composition may be terpene free, that it is sufficient to anticipate the claimed invention. The standard for anticipation, however, is not suggestion but rather, **disclosure**. See *In re Levy*, supra. Nowhere within the Stevens reference is a terpene-free composition **disclosed**. As a result, Appellant submits that for this reason alone, this reference should not serve to anticipate the present invention.

Furthermore, as for the limitations associated with claimed components (a) and (b), i.e., from about 2 to about 12% by weight of an oil-soluble anionic surfactant and from about 0.2 to 6% by weight of a water-soluble surfactant, the Examiner contends that they are found in Stevens at col. 4, lines 40-45, and col. 3, lines 20-22. However, upon a careful reading of col. 4, lines 40-45, it is seen that Stevens teaches the use of an oil-soluble surfactant as being **merely optional**, and not mandatory as is presently claimed. While Appellant appreciates the Examiner's attempt at defining the term "optional" in a way which anticipates the claimed invention, such an exercise is believed to be impermissible. For example, where Stevens teaches that the presence of terpene in its composition is optional, see col. 3, lines 42-46, the Examiner interprets this as meaning terpene is NOT to be employed, thereby rendering this element of the claimed invention anticipated. Similarly, where Stevens teaches the presence of oil-soluble surfactants as being **ptional**, see col. 4, line 40, the Examiner interprets this as meaning they are, in

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fact, to be present in its composition. This type of self-serving interpretation should not form the basis for an anticipation rejection. As was mentioned previously, a determination of anticipation requires the **disclosure** of each and every element of the claimed invention, not its **suggestion**. See, *In re Levy*, supra.

Moreover, this reference also fails to disclose the use of the claimed amounts of oil-soluble anionic surfactant and water-soluble anionic surfactants in its composition. Instead, this reference merely teaches the total amount of any and all surfactants, **in general**, which may be present in its composition. Once again, Appellant would like to note that it is well settled that each and every element of a claimed invention must be disclosed within a prior art reference for it to anticipate said invention. A generic teaching relating to a range of surfactants which may be present in a composition fails to satisfy the burden of proof required to establish an invention's anticipation by a prior art reference. ③

Finally, Appellant would also like to note that this reference's teaching must be read in light of the fact that its composition is directed to cleaning **textiles**, whereas the claimed composition is intended to be used for cleaning hard surfaces. The amount and type of surfactant used in textile cleaning compositions typically differs from those employed in hard surface cleaning compositions. ✓

The Stevens '031 reference fails to contain the requisite teaching or suggestion to motivate the routineer to wish to employ the compounds and weight percent amounts disclosed in claims 35 and 43 of the present invention.

With respect to claim 35, the Stevens reference admittedly fails to teach the use of the claimed isopropyl amine salt of dodecylbenzene sulfonic acid. In an effort to overcome this admitted lack of teaching, the Examiner contends that because this reference teaches an alkyl amine dodecylbenzenesulfonate, it would therefore be obvious to employ the claimed isopropyl amine salt of dodecylbenzene sulfonic acid. Appellant respectfully disagrees with the Examiner's premise upon which the conclusion of obviousness is based,

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for the following reason.

The requisite motivation for the routineer to wish to employ the claimed isopropyl amine salt of dodecylbenzene sulfonic acid is still believed by Appellant to be lacking. The number of alkyl amine dodecylbenzenesulfonate permutations encompassed by the generic definition of this compound are numerous. Thus, to believe that the routineer would be motivated to choose the claimed **isopropyl amine salt** of dodecylbenzene sulfonic acid, rather than any of the other numerous candidates, is believed by Appellant to be an example of an improper "obvious-to-try" rationale. More particularly, it is well settled that where the prior art gives either no indication as to which parameters are critical or no direction as to which of many possible choices is likely to be successful, prima facie obviousness may not be based on an improper "obvious-to-try" rationale. See, In re O'Farrell, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988). Clearly, such is the case here. (5)

The same reasoning holds true for claim 43 and its use of a propylene glycol n-butyl ether short-chain cosurfactant. Nowhere within the four corners of the Stevens '031 reference is there provided any disclosure which might motivate the routineer to wish to employ the claimed propylene glycol n-butyl ether, as opposed to any of the other numerous candidates encompassed by Stevens' teaching regarding the use of a glycol ether in its composition.

Finally, the Stevens' '031 reference fails to teach or suggest the use of the claimed amounts of isopropyl amine salt of dodecylbenzene sulfonic acid and propylene glycol n-butyl ether. As was noted earlier by Appellant, Stevens merely provides some insight into the **total amount** of surfactant which may be employed in its composition. To assume that the routineer would wish to employ the claimed amounts of isopropyl amine salt of dodecylbenzene sulfonic acid and propylene glycol n-butyl ether based on Stevens' general disclosure regarding the total amount of surfactant which may be employed, once again amounts, in Appellant's opinion, to the use of an improper "obvious-to-try rationale". This is especially true when one takes into account that this reference's teaching, and the

not encompassed in scope

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motivation which it inspires, must be read in light of the fact that its composition is directed to cleaning **textiles**, whereas the claimed composition is intended to be used for cleaning hard surfaces. The amount and type of surfactants used in a textile cleaning composition typically differ from those employed in hard surface cleaning compositions. It cannot be presumed that they are interchangeable and therefore, prima facie obvious. This, too, will have an effect on the routineer's motivation as to which type of components to employ in the Stevens' composition.

Neither the Stevens '031 reference nor the Van Eenam '341 reference, alone or in combination, contain the requisite teaching or suggestion to motivate the routineer to wish to employ the compounds and weight percent amounts disclosed in claims 49 and 50 of the present invention, so as to render the claimed invention prima facie obvious.

The Stevens' reference admittedly fails to contain any teaching or suggestion relating to the use of a cyclic ketone in its composition and, specifically, the claimed cyclohexanone. In an effort to overcome this admitted lack of teaching or suggestion, the Examiner relies upon the '341 reference for its alleged teaching regarding the use of cyclohexanone as an organic solvent in hard surface cleaners/degreasers.

The shortcomings associated with the Stevens reference are as outlined above. In view of said shortcomings, even if the Stevens' reference were to be combined with the Van Eenam reference, as is suggested by the Examiner, they would nevertheless fail to render the claimed invention prima facie obvious on the grounds that each and every element of said claimed invention is neither taught nor suggested by the combined teachings of the prior art references.

Neither the Stevens '031 reference nor the Cilley '583 reference, alone or in combination, contain the requisite teaching or suggestion to motivate the

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routineer to wish to employ the compounds and weight percent amounts disclosed in claims 53 and 54 of the present invention, so as to render the claimed invention prima facie obvious.

The Stevens' reference admittedly fails to contain any teaching or suggestion relating to the use of a thickening agent in its composition and, specifically, the claimed bentonite. In an effort to overcome this admitted lack of teaching or suggestion, the Examiner relies upon the '583 reference for its alleged teaching regarding the use of thickeners in hard surface cleaners/degreasers.

Here too, the shortcomings associated with the Stevens' reference are as outlined above. In view of said shortcomings, even if the Stevens' reference were to be combined with the Cilley reference, as is suggested by the Examiner, they would nevertheless fail to render the claimed invention prima facie obvious on the grounds that each and every element of said claimed invention is neither taught nor suggested by the combined teachings of the prior art references.

SUMMARY

The term "thermally stable", when read in light of the specification and the art, is sufficiently definite to satisfy the requirements of section 112, second paragraph.

The Stevens' reference fails to anticipate the claimed invention because it fails to disclose each and every claimed element thereof.

The Stevens '031 reference fails to contain the requisite teaching or suggestion to motivate the routineer to wish to employ the compounds and weight percent amounts disclosed in claims 35 and 43 of the present invention.

Neither the Stevens '031 reference nor the Van Eenam '341 reference, alone or in combination, contain the requisite teaching or suggestion to motivate the routineer to wish to employ the compounds and weight percent amounts disclosed

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in claims 49 and 50 of the present invention, so as to render the claimed invention **prima facie obvious**.

Neither the Stevens '031 reference nor the Cilley '583 reference, alone or in combination, contain the requisite teaching or suggestion to motivate the routineer to wish to employ the compounds and weight percent amounts disclosed in claims 53 and 54 of the present invention, so as to render the claimed invention **prima facie obvious**.

It is requested for the reasons given above, that the Board find for Appellant on all of the issues, and reverse the Examiner's Final Rejections.

Respectfully submitted,



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Enc.: Appendix

APPENDIX

CLAIMS ON APPEAL

33. A process for cleaning a hard surface comprising contacting the surface with a cleaning-effective amount of a terpene-free cleaning composition containing:

(a) from about 2 to about 12% by weight of an oil-soluble anionic surfactant;

(b) from about 0.2 to about 6% by weight of a water-soluble anionic surfactant;

(c) from about 3 to about 96% by weight of a primary solvent consisting of a C₁₋₄ alkyl ester of a C₆₋₂₂ saturated or unsaturated carboxylic acid;

(d) from about 2 to about 14% by weight of a short-chain cosurfactant; and

(e) remainder, water, all weights being based on the total weight of the composition.

34. The process of claim 33 wherein the oil-soluble anionic surfactant is selected from the group consisting of amine salts of dodecylbenzenesulfonic acid, calcium salts of dodecylbenzenesulfonic acid, phosphate esters, and mixtures thereof.

35. The process of claim 33 wherein the oil-soluble anionic surfactant is an isopropylamine salt of dodecylbenzenesulfonic acid.

36. The process of claim 33 wherein the oil-soluble anionic surfactant is present in the composition in an amount of from about 6 to about 8% by weight, based on the weight of the composition.

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37. The process of claim 33 wherein the water-soluble anionic surfactant is selected from the group consisting of alkali metal salts of fatty acids, organic base salts of fatty acids, alkyl sulfates, alkyl ether sulfates, alkyl aromatic sulfonates, alkyl sulfonates, alpha olefin sulfonates, sulfosuccinates, and mixtures thereof.

38. The process of claim 33 wherein the water-soluble anionic surfactant is a C12-C14 fatty alcohol sulfate.

39. The process of claim 33 wherein the water-soluble anionic surfactant is present in the composition in an amount of from about 1 to about 2% by weight, based on the weight of the composition.

40. The process of claim 33 wherein the primary solvent is a C₈-C₁₀ methyl ester.

41. The process of claim 33 wherein the primary solvent is present in the composition in an amount of from about 40 to about 50% by weight, based on the weight of the composition.

42. The process of claim 33 wherein the short-chain cosurfactant is selected from the group consisting of C₃-C₆ alcohols, glycols, glycol ethers, pyrrolidones, glycol ether esters, and mixtures thereof.

43. The process of claim 33 wherein the short-chain cosurfactant is propylene glycol n-butyl ether.

44. The process of claim 33 wherein the short-chain cosurfactant is present in the composition in an amount of from about 8 to about 10% by weight, based on the weight of the composition.

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45. The process of claim 33 wherein the composition has a pH value of less than about 9.

46. The process of claim 33 wherein the composition has a thermal stability ranging from about 10 to about 70°C.

47. The process of claim 33 wherein the primary solvent and water are present in the composition in a ratio by weight ranging from about 50:1 to about 1:4.

48. The process of claim 33 wherein the primary solvent and water are present in the composition in a ratio by weight of about 1.5:1.

49. The process of claim 33 wherein the terpene-free cleaning composition further comprises from about 1 to about 35% by weight of a cyclic ketone.

50. The process of claim 49 wherein the cyclic ketone is cyclohexanone.

53. The process of claim 33 wherein the cleaning composition further contains a thickening agent.

54. The process of claim 53 wherein the thickening agent is tetraalkyl ammonium bentonite.